

**REMARKS**

Entry of the above amendments to the Claims is respectfully requested. Claims 1-44 were originally filed. Claims 2-3, 12, 17, and 31-44 were previously canceled in the Responses to the first two Office Actions. Claims 1, 4-11, 13-16 and 18-30 are currently pending, of which Claim 1 and Claim 29 are amended herein. Reconsideration of the claimed subject matter is hereby respectfully requested in view of the foregoing Amendments to the Claims and the following Remarks.

**Continued Rejection of Claims 16 and 18-29 Under 35 U.S.C. 112, ¶ 2:**

The rejection of claims 16, 18-29 on 35 U.S.C. 112, ¶2 still stands. In particular, the Examiner contends that Claim 29 indicates that  $R^4$  is hydrogen and Claim 1 has no antecedent basis of it being hydrogen. Applicants traverse this rejection for the following reasons:

With respect to Claims 16 and 18-28, Applicants respectfully submit that these Claims do not contain this limitation for  $R^4$ . Accordingly, Applicants respectfully request that this rejection with respect to Claims 16 and 18-28 be withdrawn.

With respect to Claim 29, Applicants have amended this Claim to replace the  $R^4$  limitation with a recitation that  $n$  is 0. Claim 1 has antecedent basis for  $n$  being 0. Accordingly, Applicants respectfully submit that rejection of Claim 29 under 35 U.S.C. 112, ¶2, is now overcome.

**Withdrawal of the Rejection of Claims 1, 2 4 13 under 35 U.S.C. 102(b):**

The Examiner states in the Office Action that the rejection of "Claims 1, 2 4" under 35 U.S.C. 102(b) over Mirek *et al.* has been withdrawn.

Applicants would like to direct the Examiner's attention to the apparent typographical error in the Examiner's listing of the Claims in this withdrawal. The Examiner lists Claims 1, 2 4 as the claims upon which the rejection under 35 U.S.C. 102(b) was withdrawn. Applicants respectfully submit that the correct listing of the Claims should be *Claims 1, 4 and 13*. Support for this may be found in the first Office Action where Claims 1, 2, 4 and 13 were

rejected under 35 U.S.C. 102(b) as being unpatentable in view of Mirek *et al.* In the Response to this Office Action, Claim 2 was cancelled, leaving only Claims 1, 4 and 13 as being rejected. Accordingly, the correct listing of the Claims upon which the rejection under 35 U.S.C. 102(b) was withdrawn should be **Claims 1, 14 and 13**. Applicants thank the Examiner in advance for her confirmation in writing that this is indeed the correct listing of the Claims upon which this rejection was withdrawn.

**Continued Rejection of Claims 1, 5-6 and 8 under 35 U.S.C. 112, ¶1:**

The rejection of Claims 1, 5, 6, and 8 under 35 U.S.C. 112, ¶ 1, still stands. In particular, the Examiner contends the following:

*The specification [does] not teach any compounds with R<sup>4</sup> substituents. Besides with n=3 and R<sup>4</sup> being heterocyclic aliphatic ring, with all the other positions already substituted would require more than ordinary skill in the art to make and use. The examples provided do not have any guidance of compounds with any R<sup>4</sup> other than it being H.*

Applicants respectfully traverse this rejection for the following reasons:

Applicants respectfully submit that the specification does indeed teach a compound having an R<sup>4</sup> substituent. For example, Examples 13, 14 and 15 on pages 41-43 disclose the preparation of compounds of the invention wherein n is 1 and R<sup>4</sup> is chloro. These compounds can easily be treated with an appropriate nucleophile under standard nucleophilic substitution conditions known to one skilled in the art to produce other compounds of the invention wherein n is 1 and R<sup>4</sup> is as described in Claim 1.

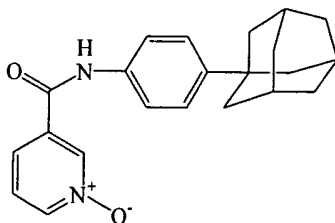
In addition, Applicants respectfully submit that the one of ordinary skill in the art, armed with the knowledge of such standard nucleophilic substitution conditions, would clearly be able to also prepare compounds of the invention where n is 2 or 3, especially in view of the teachings of the Specification. For example, the Specification discloses on page 19 several U.S. patents that teach how to make the appropriate nicotinic acid starting material for such compounds (these patents, which are U.S. 3,950,160, U.S. 3,766,195, and U.S. 3,637,716, are disclosed in a Supplemental Information Disclosure Statement filed herewith). Other appropriately substituted starting materials are known (see, *e.g.*, the tri- and tetra-substituted compounds disclosed in the references cited by the Examiner in the rejection of Claim 1 under

35 U.S.C. 102(b) discussed below) or could be prepared by methods known to one skilled in the art. However, in the interest of advancing this application to early issuance, Applicants have amended Claim 1 so that n can only be 0 or 1. Accordingly, Applicants respectfully submit that the rejection of Claims 1, 5-6 and 8 under 35 U.S.C. 112, ¶1, is now overcome.

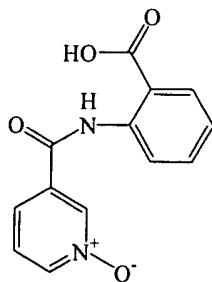
**New Rejection of Claim 1 under 35 U.S.C. § 102(b):**

The Examiner newly rejected Claim 1 under 35 U.S.C. 102(b) in light of the following Chemical Abstracts (taken individually):

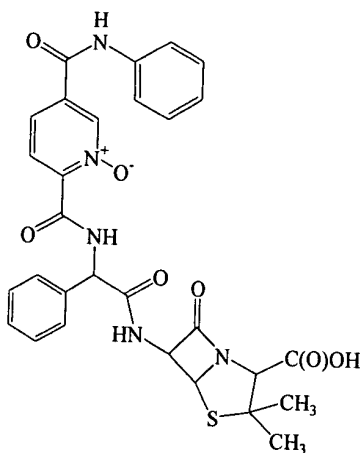
1. DN 86:89560 (Danilenko, G.I., *et al.*, *Khimiko-Farmatsevticheskii Zhurnal* (1976), 10(8), 51-3, which discloses the following compound:



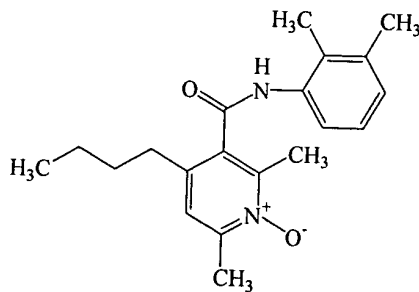
2. DN 87:5812 (Soviet Union Patent No. 539878), which discloses the following compound:



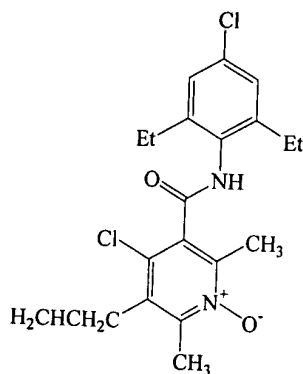
3. DN 97:215892 (Japanese Patent Application 57109792), which discloses the following compound:



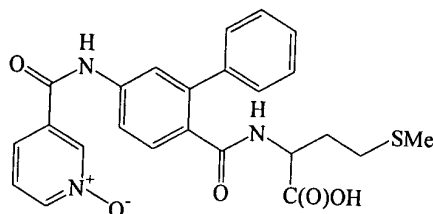
4. DN 109:68852 (Japanese Patent Application 63017811), which discloses the following compound:



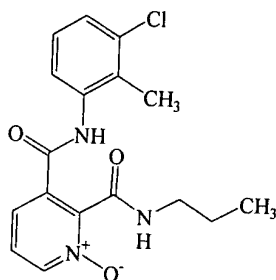
5. DN 110:154162 (European Patent 292990), which discloses the following compound:



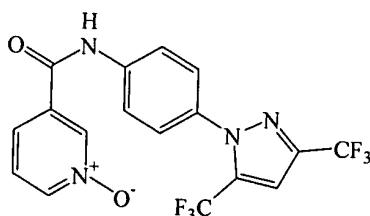
6. DN 127:51002 (PCT Published Patent Application WO 97/17070), which discloses the following compound:



7. DN 127:331402 (European Patent 799825), which discloses the following compound:



8. DN 132:22963 (PCT Published Patent Application WO 99/62885), which discloses the following compound:

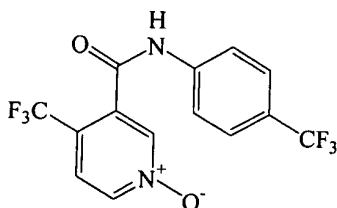


Applicants have amended Claim 1 so that  $R^1$  can not be hydrogen in the claimed compounds. Accordingly, Reference Nos. 1-2 and 6-8, wherein the compounds disclosed therein have  $R^1$  as being hydrogen, do not anticipate the claimed compounds. Furthermore, since Claim 1 has been amended so that  $n$  is only 0 or 1, Reference Nos. 4 and 5, wherein the compounds disclosed there have  $n$  as being 2, do not anticipate the claimed compounds. Finally, Claim 1 has also been amended by adding a proviso which specifically excludes the compound disclosed in Reference No. 3 from the scope of the claimed compounds. The introduction of this proviso is not considered adding new matter to the Specification in that the Applicants are merely excising the invention of another from their claimed invention (see *In re Johnson and Farnham*, 194 USPQ 187, and *In re Driscoll*, 195 USPQ 434).

Accordingly, Applicants respectfully submit that the rejection of Claim 1 under 35 U.S.C. 102(b) is now overcome.

**Rejection of Claim 1 under 35 U.S.C. § 102(a):**

Claim 1 is rejected under 35 U.S.C. 102(a) as being anticipated by Chemical Abstracts DN 133:135326 (Japanese Patent Application 2000226372), which discloses the following compound:



Claim 1 has been amended so that R<sup>1</sup> can not be hydrogen. Accordingly, Applicants respectfully submit that the rejection of Claim 1 under 35 U.S.C. 102(a) is now overcome.

**Conclusion:**

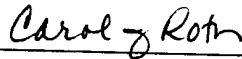
Applicants respectfully submit that all rejections to the Claims as set forth in the final Office Action are now overcome and that all of the Claims remaining in the application are now clearly allowable. Favorable consideration and a Notice of Allowance are earnestly solicited at an early date.

The Commissioner is authorized to charge any additional fees due by way of this Amendment, or credit any overpayment, to our Deposit Account No. 19-1090.

Respectfully submitted,

Neil S. Cutshall et al.

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